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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,645	12/22/2000	Aman Gupta	GEMS8081.056	4526
26629	7590	08/03/2005	EXAMINER	
ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (ZPS)			JEANTY, ROMAIN	
14135 NORTH CEDARBURG ROAD			ART UNIT	
MEQUON, WI 53097			PAPER NUMBER	

3623

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/747,645

Applicant(s)

GUPTA ET AL.

Examiner

Romain Jeanty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Response to Amendment**

1. This communication is in response to the amendment filed March 18, 2005.

Claims 1-26 are pending in the application. Applicant's amendment to claim 3 has overcome the 35 USC §112 rejection.

### **Claim Rejections - 35 USC § 101**

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts of:

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

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Furthermore, mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

While claim fails to produce a useful, concrete, and tangible result (measuring the product shipment process capability). The claims further deems to be non-statutory for failure to apply, involve, use, or advance the technological arts. In order to overcome this rejection, it is respectfully suggested that the claims be amended to expressly incorporate technology (i.e., a computer processor) as performing at least one of the steps of the invention (i.e., a measuring step). Appropriate correction is required.

Claims 2-10 depend from independent claim 1; and therefore are rejected under the same rationale of claim 1.

4. Claims 17 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts of:
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

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Furthermore, mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

The claim fails to produce a useful, concrete, and tangible result (measuring the product shipment process capability). The claim further deems to be non-statutory for failure to provide a concrete and tangible result. For example, the claim recited displaying a statistical value. However, the value is not being used to perform any function. In order to overcome this rejection, it is respectfully suggested that the claims be amended to use the statistical value to do something. Appropriate correction is required.

Claims 18-26 depend from independent claim 17; and therefore are rejected under the same rationale of claim 17.

#### **Response to Argument**

5. Applicant's arguments have overcome the 35 USC §112 rejection.
6. Applicant's arguments with regard to the 35 USC §101 rejection have been fully considered but they are not persuasive because:

Applicant has argued that the previous the current rejection is inconsistent with the examiner's previous indication that the claims were within statutory classes, and that the examiner previously expressed a belief that the claims were statutory. In response, upon further review of the claims and reviewing the 101 guidelines, the examiner was obliged to reject the claims under 35 USC §101.

Applicant has argued that the instant claims as presented contain statutory subject matter as was the case in *State Street* and *AT&T v. Excel*. In response, section MPEP

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2106 II requires that an analysis for statutory subject matter of software-related patents must necessarily be in accordance with the holdings in the recent Federal Circuit cases of State Street (State Street Bank & Trust Co. v. Signature Financial, 149, F.3d 1368; 47 USPQ 2D (BNA) 1596 (Fed. Cir. 1998)) and AT&T (AT&T Corp. v. Excel Communications, Inc., Excel Communications Marketing, Inc., and Excel Telecommunications, Inc., 172 F.3d 1352; 1999 U.S. App. Lexis 7221; 50 U.S.P.Q. 2D (BNA) 1447 (Fed. Cir. 1999)).

The Federal Circuit stressed on the earlier presented language found in *In re Allappat*, 33 F.3d 1526, 32 U.S.P.Q. 2D (BNA) 1545 (Fed. Cir. 1994, en banc), that the appropriate standard for statutory subject matter of software patents was whether the invention, as a whole, operates to produce a “useful, concrete and tangible result”.

Here, in claim 1, the only recitation of a **database** (i.e. the database recited in the claim is not an electronic database) in the body of the claim. The body of the claims does depend on the preamble to involve a computer or any components of a computer. The independent claim 1 and its dependent claims as recited do not even hint the guidance given by the Federal Circuit in the *State Street Bank* decision in cases involving a practical application in the technological arts.

In the instant claims there are no useful, concrete or tangible result that is determine by a machine or a computer implemented process. The invention in the body of the claims is not tied to any technological art. Applicant is reminded that the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)). Even though *Bowman* is not precedential, *Bowman* is being cited for its analysis of whether the claim is in the technological arts;

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also note MPEP 2106 IV 2(b). Merely nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not affect or effect the underlying process.

Further support by the Examiner is found in *In re Toma* where it is sated “ ‘technological arts’ or ‘useful’ arts inquiry must focus on whether claimed subject matter, for example, method operating machine to translate, is statutory, not on whether product of claimed subject matter, for example, translated text, is statutory, not on whether prior art that claimed subject matter purports to replace, for example, translation by human mind, is statutory, and not on whether claimed subject matter is presently perceived to be improvement over prior art, for example whether it enhances operation of machine; this was the law prior to *Gottschalk v. Benson*, 175 USPQ 673, and was not changed by *Benson*.” (emphasis added) 197 USPQ 852, 853 (CCPA 1978). In *In re Musgrave*, 167 USPQ 280 (CCPA 1970), it was held that ...all that is necessary to make a sequence of operational steps a statutory ‘process’ within 35 USC 101 is that it built in the technological arts so as to be in consonance with Constitutional purpose to promote progress of ‘useful arts’...” (emphasis added).

Applicant has argued that claim 1 produces a concrete, useful and tangible result because claim1 explicitly states what the statistical calculation provides an indication of process quality. In response, the examiner respectfully disagrees because the preamble of the claim recites a method for measuring product shipment process capability, and there is no measuring step in the body of the claim. Thus the claim does not produce a concrete, useful, and tangible result.

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### Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

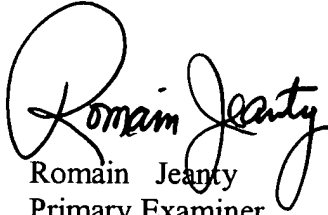
a. Martin et al (US Patent No. 5809479) discloses a method for reporting status of work in progress.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (571) 272-6732. The examiner can normally be reached on Mon-Thurs 7:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 31, 2005

  
Romain Jeanty  
Primary Examiner  
Art Unit 3623